

**DOCKET NO.: CSKL0004-100****PATENT****REMARKS**

Claims 6-24 were pending in the present application. Claims 23 and 24 were indicated in the Office Action to be withdrawn; Applicants have canceled cancelled claims 23 and 24 without prejudice to their presentation in another application. Claims 17, 20, and 22 have been amended to be even more clear. No new matter has been added. Upon entry of the present amendment, claims 6-22 will be pending.

Applicants acknowledge that three particular references recited on the Information Disclosure Statement have been lined through and not considered by the Examiner. Applicants will endeavor to forward copies of these references to the Examiner as soon as possible.

**I. The Claimed Invention Is Not Obvious**

Claim 24 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Drenckhahn et al., J. Biol. Chem., 1986, 261, 12754 (hereinafter, the "Drenckhahn reference"). Although Applicants disagree with the reasons set forth in the Office Action, solely to advance prosecution of the present application, claim 24 has been cancelled (claim 24 has also been indicated in the Office Action to be withdrawn). Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §103(a) be withdrawn.

**II. The Claims Are Clear And Definite**

Claims 6-22 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Applicants traverse the rejection and respectfully request reconsideration because the claims are clear and definite.

The Office Action asserts that claim 6 is indefinite as to the "manifestations of 'stability'" and whether any component in the composition can be stabilized. Applicants traverse this rejection and respectfully request reconsideration. Claim 6 need not recite any results or "manifestations" of the recited steps in order to be definite. Indeed, the claim is sufficiently definite in its present form. Any "manifestations", including those cited by the Examiner, that stabilize the pyrene actin within a composition falls within the scope of claim 6. Applicants remind the Examiner that one of ordinary skill in the art (such as a protein chemist) would be

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readily familiar with stabilizing proteins. Applicants also remind the Examiner that the entire application is directed to stabilizing the pyrene actin in a composition, not to stabilizing sucrose or the stabilizing agent. Thus, one of ordinary skill in the art would recognize that the claimed method stabilizes the pyrene actin in the composition. The method may, however, stabilize additional components as well. Persons of ordinary skill would have no difficulty in determining whether a particular method meets the features recited in the claim. Accordingly, claim 6 is definite within the meaning of §112. *In re Mercier*, 185 U.S.P.Q. 774 (C.C.P.A. 1975) (claims sufficiently define an invention so long as one skilled in the art can determine what subject matter is or is not within the scope of the claims).

The Office Action also asserts that recitation of "the composition of step (b)" in claims 7 and 8 lacks literal support. Step (b) of claim 6 recites "mixing the concentrated pyrene actin composition with sucrose and a stabilizing agent." Thus, quite clearly, when the concentrated pyrene actin composition is mixed with sucrose and a stabilizing agent in step (b), a new composition comprising the concentrated pyrene actin, sucrose, and stabilizing agent is formed. Thus, recitation of "the composition of step (b)" in claims 7 and 8 is an inherent feature of step (b) of claim 6. *Ipsis verbis* recitation is not required for the claims to be clear and definite.

The Office Action asserts that recitation of "said frozen composition" in claim 9 lacks literal support. Claim 8 recites, in part, "wherein the composition of step b) is rapidly frozen." Claim 9 depends upon claim 8. Thus, quite clearly, when claim 9 recites "said frozen composition" it refers to the composition of claim 8 which has been "frozen." Thus, recitation of "said frozen composition" in claim 9 is an inherent feature of step (b) of claim 8.

The Office Action asserts that it is unclear in claim 12 to which of the compositions is being referred. Claim 12 recites, in part, "wherein said composition is rapidly frozen in liquid nitrogen or a dry ice ethanol bath." Claim 12 depends on claim 8 which recites, in part, "wherein the composition of step b) is rapidly frozen." Thus, quite clearly, claim 12 refers to the composition of step b) (which refers to claim 6, on which claim 8 is dependent). Thus, the composition formed upon carrying out step b) of claim 6 is rapidly frozen (per claim 8). The rapid freezing recited in claim 8 is then further described in claim 12 to be via liquid nitrogen or a dry ice ethanol bath. Persons of ordinary skill would have no difficulty in determining whether

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a particular method meets the criteria recited in claim 12. Accordingly, claim 12 is definite within the meaning of §112. *In re Mercier, Id.*

The Office Action asserts recitation of "said composition" in claim 17 is unclear as to which composition is being referred. Although Applicants maintain that claim 17 is clear and definite as presently written, solely to advance prosecution of the present application, claim 17 has been amended to recite "pyrene actin composition."

The Office Action asserts that recitation of a concentration of sucrose in claims 18 and 19 is indefinite because it apparently is not clear whether any sucrose and/or stabilizing agent was present before mixing. Claim 6 recites that the pyrene actin composition is mixed with sucrose and a stabilizing agent. Claims 18 and 19 simply recite that the sucrose is present at 5% w/v and the stabilizing agent is present at 1% w/v. Clearly, these claims recite that the final concentration of the sucrose and stabilizing agent once mixed with the pyrene actin composition is 5% and 1% w/v, respectively. One of ordinary skill in the art would quite readily understand this. There may or may not be additional sucrose and/or stabilizing agent in the pyrene actin composition prior to mixing as recited in step b). The final concentration, however, is as recited in the claim.

The Office Action asserts that "A-buffer" should be defined in the claims. Applicants respectfully point out, however, that the description of the invention is the role of the specification, not the claims. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986). Definition of "A-buffer" is set forth on, for example, page 4 of 10 of the specification (A-buffer: 5 mM Tris pH 8, 0.2 mM CaCl<sub>2</sub>, 0.2 mM ATP). In addition, the amount of detail required to be included in the claims is not to be viewed in the abstract but in conjunction with the specification. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 225 U.S.P.Q. 634 (Fed. Cir. 1985). As such, the specification provides ample definition of "A-buffer".

The Office Action asserts that recitation of "the lyophilized actin" and "said resuspended actin" in claim 20 lacks antecedent basis. Although Applicants maintain that claim 20 is clear and definite as presently written, solely to advance prosecution of the present application, claim 20 has been amended to recite "the lyophilized pyrene actin composition" and "said resuspended pyrene actin composition". Clearly, the "the lyophilized pyrene actin

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composition" is the composition of claim 9 that has been lyophilized. Also, clearly "said resuspended pyrene actin composition" is the "the lyophilized pyrene actin composition" which has been resuspended per step a) of claim 20.

The Office Action asserts that recitation of "said actin" in claim 22 lacks antecedent basis. Claim 21 recites, in part, "wherein said resuspended actin is centrifuged" (referring to claim 20). Claim 22 simply recites that the actin is centrifuged at 100,000 x g. To be even more clear, however, Applicants have amended claim 22 to recite "wherein said resuspended actin is centrifuged at 100,000 x g."

In view of the foregoing, claims 6-22 are clear and definite. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §112, second paragraph be withdrawn.

### **III. Conclusion**

In view of the foregoing, Applicants respectfully submit that the claims are in condition for allowance. An early notice of the same is earnestly solicited. The Examiner is invited to contact Applicants' undersigned representative at (215) 665-6914 if there are any questions regarding Applicants' claimed invention. Applicants also request that an interview if a Notice of Allowance is not forthcoming.

Respectfully submitted,



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